

**B. Identification of rejections discussed:**

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Allam in view of Pruett.

**C. Identification of principal proposed amendments:**

None.

**D. Brief Identification of principal arguments:**

First, Applicant's representative again noted that the Amendment filed on September 5, 2006 specifically noted that the un-executed declaration under 37 C.F.R. § 1.131 was being filed to expedite the Examiner's consideration of the application, and that the executed declaration would be filed upon receipt from the inventor (see Amendment under 37 C.F.R. § 1.111 filed on September 5, 2006, at page 11, lines 4-8).

Accordingly, the executed Declaration under 37 C.F.R. § 1.131 was filed in the USPTO via facsimile on November 14, 2006, as evidenced by the PTO facsimile filing receipt, and the "Transaction History" and "Available Documents" obtained from the USPTO PAIR site.

As indicated on the PAIR site, Applicant's representative again noted that the present Office Action was entered on November 24, 2006, and mailed on November 27, 2006, which was after the filing of the executed Declaration under 37 C.F.R. § 1.131 on November 14, 2006.

Thus, the Examiner properly should have entered and considered the executed Declaration, which was filed on November 14, 2006, prior to issuing the present Office Action.

Indeed, since the un-executed Declaration and the executed Declaration were identical, except for the inventors' signatures, sufficient time clearly was available to enter and consider the executed Declaration prior to entering the Office Action on November 24, 2006, and subsequently mailing the same on November 27, 2006.

It was noted that the Examiner has considered the content of the unexecuted Declaration, although the subsequently filed executed Declaration was not entered.

Second, with respect to the Examiner's allegation that the "declaration does not contain the invention disclosure statement correlating to the claims," Applicant's representative again noted that the Declaration under 37 C.F.R. § 1.131 clearly includes a statement that the inventor is the sole inventor of the above-identified application (see Declaration under 37 C.F.R. § 1.131, at numbered paragraph (1)). Clearly, since Applicant is the sole inventor of the present application, the Applicant is the sole inventor of all of the claims of the present application.

Moreover, Applicant's representative pointed out that paragraph 5 of the Declaration clearly states that:

5) The contents of the enclosed "Invention Disclosure Documents" (Exhibit 1) have been incorporated into the specification of the present invention, upon which claims 1-14 are based.

Moreover, Applicant's representative argued that all of the requirements for filing a Declaration under 37 C.F.R. § 1.131 have been met by the present Declaration (e.g., see 37 C.F.R. § 1.131; see also 37 C.F.R. § 1.68; see also M.P.E.P. § 715).

It is noted that 37 C.F.R. § 1.131 states that:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of

the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e).

...  
(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained.

That is, Applicant must show invention of the subject matter of the rejected claims. In this case, the Exhibits submitted with the Declaration show invention of the subject matter of the rejected claims.

Applicant is not aware of a requirement that an invention disclosure statement that explicitly identifies the rejected claims must be made for the Declaration under 37 C.F.R. § 1.131 to be effective.

In the interview, Applicant's representative **again** requested that, should the Examiner consider this statement to be a requirement of a Declaration under 37 C.F.R. § 1.131, the Examiner is requested to identify the basis for this requirement in the applicable law, rules, or procedures.

Third, in response to the Examiner's allegation that the "declaration does not contain explanation of the contents of the invention disclosure document," it was noted that a full English language translation of the Invention Disclosure Document was submitted as Exhibit 2, together with the Declaration.

Thus, it is unclear what explanation of the contents of the invention disclosure document that the Examiner considers to be missing from the Declaration.

In the interview, Applicant's representative again requested that, should the Examiner consider this statement to be a requirement of a Declaration under 37 C.F.R. § 1.131, the Examiner is requested to identify the basis for this requirement in the applicable law, rules, or procedures.

Furthermore, during the interview, the Examiner alleged that Applicant is required to "map" the claims to the disclosure document provided with the Declaration under 37 C.F.R. § 1.131. Applicant's representative indicated that he was not aware of such a requirement. The Examiner, however, was not able to provide any support for such a requirement.

For the foregoing reasons, Applicant submitted that the Declaration under 37 C.F.R. § 1.131 filed on November 14, 2006 properly should have been entered by the Examiner.

Moreover, Applicant submitted that the Allam reference should be removed as prior art, since Applicant has perfected the claim to foreign priority and properly filed a Declaration under 37 C.F.R. § 1.131 showing invention of the subject matter of the present application prior to the effective filing date of the Allam reference.

Applicant reiterated that the § 102(e) date of October 23, 2002 of Allam is one (1) month and twenty (20) days prior to the filing date of the present application's Japanese priority document on December 13, 2002.

Therefore, Allam should be removed as prior art under 35 U.S.C. § 102(e) because Applicant (1) perfected the claim to foreign priority based on JP 2002-361998, which was filed on December 13, 2002, by the filing a verified English translation thereof on September 5, 2006; and (2) filed the executed Declaration under 37 C.F.R. § 1.131 which properly swears behind the critical date (i.e., October 23, 2002) of Allam, by establishing

invention of the subject matter of the present application before the Allam reference's effective § 102(e) prior art date of October 23, 2002.

Applicant submitted that the Declaration properly swears behind the effective prior art date of the Allam reference by establishing a reduction to practice prior to the effective date of the Allam reference, or in the alternative, conception of the invention, coupled with due diligence from just before the effective date of the Allam reference up to the constructive reduction to practice of the present application by the filing of the JP 2002-361998 priority document.

For the foregoing reasons, Applicant reiterated that the Allam reference should be removed as prior art and the Examiner is requested to withdraw these rejections and to permit these claims to pass to immediate allowance.

**E. Results of the Interview:**

No agreement was reached. Despite the clear evidence provided to the Examiner, the Examiner surprisingly maintains that an executed Declaration was not timely filed. Furthermore, despite maintaining the above alleged requirements for a 1.131 Declaration, the Examiner was not able to provide any support for these requirements.

**F. Conclusion:**

The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

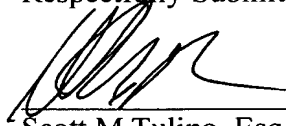
Serial No. 10/733,380  
Docket No. FJ-2003-046-US  
(MAS.018)

7

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: March 15, 2007



\_\_\_\_\_  
Scott M Tulino, Esq.  
Registration No. 48,317

Sean M. McGinn, Esq.  
Registration No. 34,386

**MCGINN INTELLECTUAL PROPERTY  
LAW GROUP, PLLC**

8321 Old Courthouse Road, Suite 200  
Vienna, Virginia 22182-3817  
(703) 761-4100  
**Customer No. 21254**